

BS01080

U.S. Application No. 09/963,483 Art Unit 2155
Response to October 28, 2005 Office Action

REMARKS

In response to the Office Action dated October 28, 2005, the Assignee respectfully requests reconsideration based on the following remarks. The Assignee again respectfully submits that the pending claims already distinguish over the cited documents.

Claims 1-2, 4-6, 12-14, 16-17, 19, 21-22, and 24 are pending in this application. The United States Patent and Trademark Office (the "Office") rejects claims 12-13 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,212,265 to Duphorne. Claims 1-2, 4-6, 14, 16-17, 19, 21-22, and 24 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Duphorne* in view of U.S. Patent 6,374,102 to Brachman *et al.* The Assignee shows, however, that the pending claims already distinguish over the cited documents.

Interview with Examiner Won

Examiner Won discussed this response. A telephone interview was held January 10, 2006 between Examiner Won and Scott Zimmerman. Examiner Won said he was not familiar with any document that associates multiple ring tones to a called party's telephone number and to email addressees. Examiner Won said the "claims are on the right track," and he suggested this response be formally submitted.

Rejection of Claims 12 & 13 under § 102

Claims 12 and 13 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,212,265 to Duphorne. Claims 12 and 13, however, have been canceled, so the rejection is moot.

Rejection of Claims under 35 U.S.C. § 103 (a)

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Claims 1-2, 4-6, 14, 16-17, 19, 21-22, and 24 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,212,265 to Duphorne in view of U.S. Patent 6,374,102 to Brachman *et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires “some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill”; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter “M.P.E.P.”). As the Assignee shows, however, the proposed combination of *Duphorne* and *Brachman* fails to teach or suggest all the features of independent claims 1, 14, and 19. One of ordinary skill in the art, then, would not find the claims obvious over *Duphorne* in view of *Brachman*. The *prima facie* case for obviousness must fail, so the Office is required to removed the § 103 rejection.

Independent claims 1, 14, and 19 are not obvious. Examiner Won is respectfully requested to carefully recognize the claimed features “*looking up the email addressee in a database to identify at least a called party's directory number and a distinctive ring tone associated with the email addressee.*” That distinctive ring tone is then retrieved “*from multiple ring tones associated with the called party's directory number, the distinctive ring tone selected by the email addressee to provide a distinct notification despite different email addresses associated with the called party's directory number.*” Support for the term “called party” may be found at least at paragraph [0026] of this pending application. A “clean” version of independent claim 1 is reproduced below, and independent claims 14 and 19 recite similar features.

1. (Currently Amended) A method for delivering a distinctive notification of an email arrival to a telephone customer premises equipment, said method comprising:

receiving a message on an application server, said message including at least an email addressee;

looking up the email addressee in a database to identify at least a called party's directory number and a distinctive ring tone associated with the email addressee;

retrieving the distinctive ring tone from multiple ring tones associated with the called party's directory number, the distinctive ring tone selected by the email addressee

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to provide a distinct notification despite different email addresses associated with the called party's directory number;

 sending an instruction from the application server, said instruction including at least the called party's directory number and the distinctive ring tone;

 causing a network node to initiate a call to the called party's directory number;

and

 sending a signal to the telephone customer premises equipment to provide the distinctive notification to the email addressee of the email arrival.

The proposed combination of *Duphorne* and *Brachman* does not obviate the claims. As the Assignee has previously argued, *Duphorne* makes no provision for storing, nor retrieving, a distinctive ring tone associated with a directory number. It is true that *Duphorne* describes a "special ringing signal" to alert of unread email messages. U.S. Patent 6,212,265 to Duphorne (Apr. 3, 2001) at column 10, lines 15-19. This special ringing signal is "periodically" provided by the central office to alert the user's telephone of unread email messages. *Id.* at column 10, lines 16-17. Because *Duphorne* makes no mention of, nor provisions for, storing and retrieving a distinctive ring tone from multiple ring tones, the only logical conclusion is that *Duphorne* provides the same "special ringing signal" to all users. That is, *Duphorne* teaches that all users receive the same "special ringing signal" when unread email messages are present.

Brachman is also silent to such features. Examiner Won is correct — *Brachman* discusses a "traditional" distinctive ringing service. See U.S. Patent 6,374,102 to Brachman *et al.* (Apr. 6, 2002) at column 2, lines 34-41. That is, *Brachman* associates distinctive ring tones to a calling party's directory number. See, e.g., *id.* at column 7, lines 48-50 and at column 75, lines 10-12. Independent claims 1, 14, and 19, however, recite "looking up the email addressee in a database to identify at least a called party's directory number and a distinctive ring tone associated with the email addressee." That distinctive ring tone is then retrieved "from multiple ring tones associated with the called party's directory number, the distinctive ring tone selected by the email addressee to provide a distinct notification despite different email addresses associated with the called party's directory number." No where, in fact, does *Brachman* make any mention of distinctive ring tones associated with "the called party's directory number," as independent claims 1, 14, and 19 recite.

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The *prima facie* case for obvious, therefore, must fail. The proposed combination of *Duphorne* and *Brachman* fails to teach or suggest many of the features recited in the independent claims. Because the proposed combination of *Duphorne* and *Brachman* is silent to such features, one of ordinary skill in the art would not find independent claims 1, 14, and 19 obvious. The respective dependent claims, then, are likewise not obvious. The *prima facie* case for obviousness must fail, so the Office is required to removed the § 103 rejection.

If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or scott@wzpatents.com.

Respectfully submitted,



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